

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 5, 8 and 19 are requested to be cancelled.

Claims 1, 3, 4, 7, 9-11, 37 and 38 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-4, 6, 7, 9-18 and 20-40 are now pending in this application.

Applicant acknowledges with appreciation the indication in the Office Action that claims 36 and 40 have been allowed and that claims 1-8 and 10-35 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112. Claims 9 and 37-39 were objected to. In view of the amendments to the claims as set forth herein, the rejections under 35 U.S.C. § 112 and the claim objections have been addressed. All of the pending claims are believed to be in condition for allowance.

As set forth in MPEP Section 608.01(m), the use of reference characters in the claims of the present application is to be considered as having no effect of the scope of the claims.

Objection is made to the proposed changes to figures 1 and 2. The Office Action appears to allege that the proposed changes eliminate some structural component of the deflection unit (e.g., prism) 17; this is not the case. Element 17 remains in both figures. The only proposed deletion was that of element 7 which, as drawn in the original figures, was not necessary and merely showed tilting, rotating, pivoting, etc. of the deflection unit 17.

The drawings were also objected to for allegedly failing to show every feature of the invention specified in the claims. For the first feature identified on page 3 of the Office Action, regarding the illumination for the reflected-in image no amendments appear to be necessary. The figures show that there are two illumination paths, one coming from the light source 11, which is directed via the beam splitter 16 over the prism 17 to the transmitted light display 21 and back via the beam splitter 23 to the main objective. The other illumination path starts at the secondary light source 18 and takes the same path after entering the prism as the latter one, namely via 21 and 23 to 12. This is also described in the specification paragraph [0045].

Regarding the second feature cited, relating to the switching of the prism for the selection of the light source, please note that per the specification at paragraph [0045], the deflection unit 17 is tiltable, rotatable, switchable and pivotable, etc. Such movement need not be shown in the drawings.

Regarding the third feature cited, relating to the control of the brightness of the reflected-in image in claim 5, Applicant has cancelled claim 5 without prejudice or disclaimer.

Regarding the fourth feature cited, relating to the use of the diaphragm recited in claims 7 and 31, Applicant submits that this is shown by reference number 19. In the parts list in the original and current specification, 19 is defined as "superimposition shutter (diaphragm)". Thus, 19 can be a shutter or a diaphragm.

Regarding the fifth feature cited, relating to the additional light source for the amplification of the intensity in claim 8, Applicant has cancelled claims 8 and 19 without prejudice or disclaimer, thus obviating the objection to the drawings.

The Office Action objected to the length and substance of the Summary of the Invention section of the specification. Appropriate amendments have been made to address this objection.

As mentioned above claims 9 and 37-39 were objected to. Claims 9, 37 and 38 have been rewritten in independent form. Claim 39 depends from claim 38. Accordingly, the objections to these claims have been traversed.

Also in the Office Action, claims 1-8 and 10-35 were rejected under 35 U.S.C. § 112, first paragraph as allegedly not enabled by the specification. Claims 5, 8 and 19 have been cancelled without prejudice or disclaimer, thus rendering the rejections to those claims moot. Regarding claims 1 and 13, the Examiner's attention is directed to paragraph [0045] of the specification. There it is described in detail that there is provided a deflection unit, e.g., a tilttable, pivotable or rotatable prism. Further the deflection unit could also be a mirror (see paragraph [0050]). In addition, Figure 3a shows the use of a deflection prism 31 in connection with two light sources 11 and 18. The working principle of deflection units in general, and prisms and mirrors especially is well known to those skilled in the field of optics. Thus, the description enables one of ordinary skill in the art to make and use the invention as claimed in claims 1 and 13. The remaining claims of the rejection depend directly or indirectly from claims 1 and 13.

Claims 1-8 and 10-25 were rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. The Office Action specifically refers to portions of claims 1, 3, 5, 8, 10, 11 and 13. Claims 5, 8 and 19 have been cancelled without prejudice or disclaimer. In view of the amendments to the claims and for at least the reasons set forth herein, this rejection has been overcome.

Claims 1 and 13 are alleged to be indefinite for their recitation of the second light source being controllable as a function of the main light source. Applicant respectfully disagrees. One example of such a control is described in the specification at paragraph [0024] (which corresponds to paragraph [0029] of the published application). The remaining issues under 35 U.S.C. § 112, identified in the Office Action have been addressed by way of the present claim amendments.

Accordingly, the rejections under 35 U.S.C. § 112 should be reconsidered and withdrawn.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date JUNE 9, 2004



Ankur D. Shah
Registration No. 41,514

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5300
Facsimile: (202) 672-5399